

## **REMARKS**

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

### **Request to Remove the Finality of the Present Premature Final Rejection**

The finality of the present final rejection is premature per MPEP 706.07.07(a) (a second or subsequent office action “*shall be final, except where the examiner introduces a new ground of rejection that is ... [not] ... necessitated by applicant's amendment*”). It is noted that claims 9-20 and 29-30 remain unamended since the last action. Hence, the assertion that Applicants’ amendment necessitated new grounds for rejection is unfounded and clearly erroneous with respect to these claims. Accordingly, reconsideration of the finality of the rejection and removal of the finality under MPEP 706.07(d) is respectfully requested. Verification of removal of the finality by telephone to the undersigned is respectfully requested in order to assure that the undersigned can appropriately adjust docket dates.

### **Request for Telephone Interview**

The present action is a **sixth Office Action** in this application. In addition, Applicants have even already persuasively briefed this matter for appeal. The extraordinary efforts to reject the present application are unnecessary, unfounded and needlessly costly to the undersigned’s client. Applicants feel that this application, now pending for over five years, should be allowed immediately, and the endless series of rejections terminated. Applicants have demonstrated willingness to cooperate toward this end in the past, and would like to discuss how to move this application forward. Unless notice of allowance is forthcoming, we believe that a further interview is the best avenue for this to be accomplished. The undersigned can be reached at the telephone number below.

### **Regarding the Claim Objection**

Claim 1 is amended in the manner explicitly requested by the Examiner. Clearly such an amendment provides no basis for necessitating a new final rejection in view of the Examiner’s explicit request for such amendment, and in view of most remaining claims being unamended.

### **Regarding all Claim Rejections**

All claim rejections are based upon the combination of Rhodes of record (extensively discussed previously) and newly cited Milton. It is noted that the Milton US 2002/0059120 A1 publication does

Serial No.: 09/891,005

not, per se, constitute prior art to the present application. Applicants have previously established in an accepted declaration under rule 131 that their date of invention dates back to at least prior to December 19, 2000 (hence clearly prior to January 22, 2001) – thus predating the Milton publication filing date. Hence, Milton is only *prima facie* prior art for that disclosed in his priority provisional application document application number 60/209,838 filed June 6, 2000 (Milton Provisional).

The undersigned has obtained and reviewed a copy of Milton Provisional and notes that this document constitutes just over six typed pages and a single figure – disclosing substantially less than the Milton publication. The undersigned further notes that in the very first paragraph thereof Milton Provisional states:

*“... [the system] ... allows Content owners to generate Static predetermined, and Dynamically generated inventories of virtual media icons, also known as Virtual Inventory Units, Inventory or Units ... Content is **never** permanently transferred to or stored by a user of the Units...” (emphasis added)*

Consider this statement of Milton Provisional in connection with claim 1, by way of example. Claim 1 calls for (to paraphrase without intent to impose further limitations):

- 1- receiving a request from a customer to store a music file, and
- 2- storing the file for the customer.

Clearly, Milton Provisional explicitly teaches away from a customer storing content or requesting storage of content (“Content is **never** ... stored by a user”). In view of this diametrically opposed teaching with that asserted to be taught by Rhodes and the explicit requirements of the claim language, there can be absolutely no basis for making the combination proposed. Hence, *prima facie* obviousness cannot be established. There must be some suggestion in the art to make the proposed combination. The evidence of record, when properly considered in light of the Milton Provisional, clearly fails to support any motivation in the art to make the proposed combination, and in fact, Milton Provisional explicitly prohibits the combination proposed. Thus, in addition to teaching away from the combination in the strongest of terms, the intended function and operation of Milton Provisional would be destroyed by allowing user data to be stored as claimed. In view of this, all rejections are fatally flawed and there can be no *prima facie* obviousness. Reconsideration and allowance of all claims are respectfully requested at an early date.

### **Concluding Remarks**

In view of this communication, all claims are believed to be in condition for allowance and such is respectfully requested. The undersigned notes that many other distinctions exist between the cited art and the claims. However, in view of the clear contradictions between Milton Provisional and Rhodes, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort. The undersigned reiterates the request to finally resolve the present matter via interview in order to avoid the need to reinstate appeal in this matter. The undersigned can be reached at the telephone number below.

Respectfully submitted,

/Jerry A. Miller 30779/

Jerry A. Miller  
Registration No. 30,779  
Dated: July 24, 2006

Please Send Correspondence to:  
Miller Patent Services  
2500 Dockery Lane  
Raleigh, NC 27606  
Phone: (919) 816-9981  
Fax: (919) 816-9982  
**Customer Number 24337**